

Taskett in view of *Moen et al.* and in further view of *Bruno et al.* (US 5,991,380); claims 5 and 13 as obvious under 35 U.S.C. § 103(a) based on *Taskett* in view of *Moen et al.* in view of *Bruno et al.* and in further view of *Nguyen et al.* (US 5,815,561); claims 6-9 and 14-17 as obvious under 35 U.S.C. § 103(a) based on *Taskett* in view of *Moen et al.* and in further view of *Gow* (US 5,828,732); claim 20 as obvious under 35 U.S.C. § 103(a) based on *Taskett* in view of *Khuc et al.*; claims 21-22, 28, and 32-33 as obvious under 35 U.S.C. § 103(a) based on *Taskett* in view of *Bruno et al.*; claims 23 and 29 as obvious under 35 U.S.C. § 103(a) based on *Taskett* in view of *Bruno et al.* and in further view of *Nguyen*; and claims 24-26, and 30 as obvious under 35 U.S.C. § 103(a) based on *Taskett* in view of *Gow*.

In regard to the rejection under §102(e) of claims 19, 27, and 31 based on *Taskett*, each of the rejected claims recites a “personal greeting” related to a telephone card. When the term “personal greeting” is properly understood in light of the specification, it is immediately clear that, even under the broadest reasonable interpretation, nothing in *Taskett* anticipates or in any way suggests playing back a “personal greeting” to a card user. When, as here, both ordinary usage and the specification make clear the meaning of a term then the claims must be examined using that meaning (MPEP 2173.05(a)). The celebrity voice that the Office Action cites is used to:

“... provide instructions on using the telephone card or may prompt the user for additional information...” (*Taskett* col. 5, lines 37-39).

Clearly, these instructions are totally impersonal messages; such instructions are not a “personal greeting.”

This difference between the claimed invention and what is taught by *Taskett* is more than functional. The system taught by *Taskett* is structurally incapable of providing “personal greetings” to users of particular pre-paid telephone calling cards. To do this requires that the

“personal greeting” be retrieved and played backed based upon identification of particular cards and card users. *Taskett*, in contrast, teaches that the message to be played back is determined by the particular telephone line used to access the system, where each line is associated with a group of cards. (col. 6, lines 14-38)

As anticipation under 35 U.S.C. § 102 requires that each and every element of the rejected claims be disclosed in a single prior art reference, based on the foregoing, it is clear that *Taskett* does not anticipate independent claims 19, 27, or 31. Further, in the absence of anything that would suggest to a person of ordinary skill in the art play back of a personal greeting, these claims cannot be considered obvious under 35 U.S.C. § 103 over *Taskett*.

With respect to the remaining rejections in the Office Action, a finding of a *prima facie* case of obviousness under 35 U.S.C. § 103(a) requires that each and every element of the rejected claims must be taught or suggested by the reference or combination of references cited and a suggestion to modify the reference or combine the reference teachings must be found in the prior art, and not based on the Applicants’ disclosure (MPEP § 706.02(j)). For the reasons set forth below Applicants submit that each of the remaining rejections fails to meet this standard.

As regards the rejection of claims 1, 10, and 16 under 35 U.S.C. § 103(a) based on *Taskett* in view of *Moen et al.* each of these claims recites “**recording a personal greeting during a setup call.**” The Office Action states:

“Taskett fails to disclose receive a request to record the greeting during a setup call.

However, Moen teaches receive a request (column 12, line 8 ‘allowing the purchaser’) to record the personal greeting during a setup call (column 12, lines 7-11) over a telephone network (column 4, line 56 ‘telecommunications network’) and to cause the personal greeting to be recorded during the setup call (column 4, lines 53-57).”

Moen et al. actually discloses, with respect to a greeting card (GC), that:

“The GC is also capable of complete customization, allowing the purchaser of the GC to put her own picture on the GC and have the GC deliver a personal message from the purchaser to the card recipient/end user.” (column 4, lines 7-11)

This language says nothing about how a personal message is to be created and recorded. Particularly, there is no suggestion that a personal message be recorded during a setup call over a telephone network. Careful review of *Moen et al.* has failed to find any teaching as to how messages are to be created and recorded in any of the various applications taught; none of which relate to pre-paid telephone card use. And, in the absence of any teaching relating to pre-paid telephone cards, there can be no suggestion to modify *Taskett* to incorporate the personal messages of *Moen et al.* since, for the reasons set forth above in regard to the rejection of claims 19, 27, and 31 the system of *Taskett* is structurally incompatible with playback of personal messages.

It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). In this instance, the Office Action has attempted to provide the requisite suggestion to incorporate the assumed capability of *Moen et al.*, which in fact fails to disclose any manner of recording personal messages, into the structurally incompatible calling card system of *Taskett* on the basis that:

“The modification of the invention would offer the capability of a request to record the greeting during a setup call such as the recipient of this card would be able to listen to the message on the greeting [sic] card.” (Applicants assume that use of “greeting” is inadvertent and that what is meant is a pre-paid telephone calling card as claimed. Clarification is requested if this assumption is not correct.)

This is no more than a recitation of the function and advantages of the claimed invention.

Recognizing, after the fact, that a modification of the prior art would provide an improvement or

advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations.

In regard to the rejection of claims 2 and 18, these claims depend from claims 1 and 16 respectively, and are believed allowable at least for the reasons set forth above with respect to claims 1 and 16.

In regard to the rejection of claims 3-4 and 11-12 under 35 U.S.C. § 103(a) based on *Taskett* in view of *Moen et al.* and in further view of *Bruno et al.*, claim 3 depends from claim 1 and claim 11 depends from claim 10, and each recites the further limitation that the data corresponding to the calling card includes a quantity corresponding to a number of service units. The Office Action states that this limitation is met by *Bruno et al.*, which, according to the Office Action, teaches, at column 2, lines 22-27:

“... the data corresponding to the pre-paid telephone calling card includes a quantity corresponding to a number of service units...”.

Bruno et al. actually teaches away from service units and instead teaches a card where an associated account stores “funds”, not service units. Funds do not directly correspond to units of service, but must be charged at various rates for various services. (*Bruno et al.* col. 3, lines 12-54) Service units, in contrast, directly correspond to units of a service (e.g., minutes of long distance service) and are debited directly without the need to apply a rate. (Specification page 20, lines 14-15) Thus, modification of the putative teaching of the present invention, as claimed in claims 1, 10, and 16, by *Taskett* in view of *Moen et al.* in accordance with the teaching of *Bruno et al.* still clearly fails to meet all the limitations of claims 3 and 11. Claims 4 and 12 depend from claims 3 and 11 and are believed allowable at least for the reasons set forth with respect to those claims.

As regards to the rejection of claims 5 and 13, these claims depend from claims 3 and 12 (depending from claim 11, depending from claim 10) respectively, and are believed allowable at least for the reasons set forth above with respect to the claims from which they depend.

As regards the rejection of claims 6, 7, and 14 under 35 U.S.C. § 103(a) based on *Taskett* in view of *Moen et al.* and in further view of *Gow*, each of these dependent claims recites further limitations relating to storing a personal greeting in accordance with a card identifier corresponding to a pre-paid telephone card. The Office Action states that *Gow* meets these limitations at column 4, lines 11-15 and lines 56-60. However, close inspection of *Gow* shows that these limitations are not met.

Gow discloses a system in which a user records a message and receives a password or PIN from the system. The password identifies the message in the system. This password is then delivered by the user to the intended message recipient who uses it to access the message. In a preferred embodiment disclosed in *Gow* the user records the password on a card that can be attached to or included in a gift for the intended message recipient. However, the password taught in *Gow* cannot be considered a “card identifier” as the password does not identify the card or anything else except the message. In fact, the *Gow* system can be practiced just as well if the password is written on a candy box or simply told to intended message recipient, without the *Gow* system knowing or needing to know what, if anything, may be associated with the password.

In contrast, the term “card identifier,” as recited in claims 6, 7, and 14, does identify a particular pre-paid telephone calling card since the provider of such cards is selling the cards (or more accurately a quantity of telephone services accessed through the card) to generate revenue, and must have a means to identify particular cards, (i.e. a card identifier) so as to be able to

account for card usage as services are provided. Further, the claims 6, 7, and 14 require recording the personal message in accordance with the card identifier. Thus, *Gow* cannot be considered to suggest recording personal messages or greetings in accordance with a card identifier for a pre-paid calling card, as recited in claims 6, 7, and 14.

As regards claim 8, this claim depends from claim 1 and is believed allowable at least for the reasons set forth above with respect to claim 1.

In regard to the rejection of claim 9 under 35 U.S.C. § 103(a) based on *Taskett* in view of *Moen et al.* and in further view of *Gow*, claim 9 depends from claim 1 and recites the further limitation that the personal greeting is to be played back during an access call made using the pre-paid the calling card. The Office Action states:

“However, *Gow* teaches the personal greeting is to be played back via the pre-paid telephone calling card processing system during an access call related to the pre-paid telephone calling card, the access call made in accordance with the use of the pre-paid telephone calling card (column 4, lines 60-67).”

While *Gow* discloses play back of personal messages, it is apparent, for the reasons set forth above in regard to the rejection of claims 6, 7, and 14, that such personal messages cannot be related to a pre-paid telephone access card or played back during an access call made in accordance with the use of that card. As noted above, the password or PIN which identifies a message in *Gow* is generated by the system, and once generated the system has no way of associating that password with a pre-paid telephone calling card, or anything else except the recorded message. If an access call were made in accordance with the use of a pre-paid telephone calling card (i.e., using a card identifier) a system which functioned in accordance with the teaching of *Gow* would have no way to determine which, if any, message was related to that card. Thus, when considered as a whole, *Gow* would not suggest the further limitation of claim 9 to a person skilled in the art.

In regard to the rejection of claim 15 under 35 U.S.C. § 103(a) based on *Taskett* in view of *Moen et al.* and in further view of *Gow*, claim 15 depends from claim 10 and recites the further limitation that the personal greeting is to be played back automatically during an access call made using the pre-paid the calling card. The Office Action states:

“However, *Gow* teaches the personal greeting stored during the causing step is to be played back automatically during an access call related to the pre-paid telephone calling card (column 4, lines 56-60).”

Review of *Gow* in its entirety has failed to identify any such teaching as asserted by the Office Action. In particular, *Gow*, at column 4, lines 56-60, teaches that the caller is required to enter a PIN written in the boxes, and, for the reasons set forth above in regard to the rejection of claims 6, 7, and 14, this PIN cannot be a card identifier for a pre-paid telephone calling card. Accordingly, this play back is not automatic; i.e., initiated without further action by a user once a calling card call is initiated (Specification page 21, line 15 – page 22, line 5, Figure 3J). Therefore, the combination of *Gow* with the putative teaching of *Taskett* and *Moen et al.* does not suggest the further limitation of claim 15.

As regards the rejection of claim 16 under 35 U.S.C. § 103(a) based on *Taskett* in view of *Moen et al.* and in further view of *Gow*, Applicants note, that while the claim is included in the rejection stated in page 15, item 9 of the Office Action, there is no discussion of that rejection; and further, claim 16 was also rejected under §103(a) based on *Taskett* in view of *Moen et al.*, which would appear to make rejection based on *Taskett* in view of *Moen et al.* and in further view of *Gow* redundant. Accordingly, in the absence of any stated reasons for this rejection, Applicants will assume that including claim 16 in the listing of rejected claims in page 15, item 9 of the Office Action was inadvertent. If this assumption is not correct clarification of the rejection is requested.

In regard to the rejection of claim 17 under 35 U.S.C. § 103(a) based on *Taskett* in view of *Moen et al.* and in further view of *Gow*, claim 17 depends from claim 16 and recites the further limitation that the personal greeting is stored in a data storage system in accordance with the card identifier.

Again, it is apparent, for the reasons set forth above in regard to the rejection of claims 6, 7, and 14, that there is no suggestion in *Gow* of playing back personal messages or greetings in accordance with a card identifier for a pre-paid calling card. Therefore, the combination of *Gow* with *Taskett* and *Moen et al.* cannot suggest the further limitation of claim 17.

In regard to the rejection of claim 20, this claim depends from claim 19 and is believed allowable at least for the reasons set forth above with respect to claim 19.

In regard to the rejection of claims 21 and 28 under 35 U.S.C. § 103(a) based on *Taskett* in view of *Bruno et al.*, claim 21 depends from claim 19 and claim 28 depends from claim 27, and each recites the further limitation that the data corresponding to the calling card includes a quantity corresponding to a number of service units.

For the reasons set forth above with respect to the rejection of claims 3 and 11 it is clear that *Bruno et al.* does not suggest the use of service units, but rather teaches a card which includes funds. Thus, the combination of *Taskett* and *Bruno et al.* clearly fails to meet all the limitations of claims 21 and 28.

As regards claim 22, this claim depends from claim 21 (depending from claim 19) and is believed allowable at least for the reasons set forth above with respect to the claim from which it depends.

In regard to the rejections of claims 32 and 33, these claims depends from claim 31 and are believed allowable at least for the reasons set forth above with respect to claim 31.

In regard to the rejections of claims 23 and 29, these claims depend from claims 21 (depending from claim 19) and claim 28 (depending from claim 27), respectively, are believed allowable at least for the reasons set forth above with respect to the claims from which they depend.

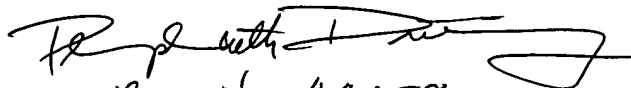
In regard to the rejection of claims 24, 25, and 30 under 35 U.S.C. § 103(a) based on *Taskett* in view of *Gow*, claim 24 depends from claim 19 and recites the further limitation that the personal greeting is played back in accordance with a card identifier corresponding to the pre-paid telephone calling card. As proffered above with respect to claims 6, 7, and 14, that there is no suggestion in *Gow* of playing back personal messages or greetings in accordance with a **card identifier** for a pre-paid calling card. Therefore, the combination of *Gow* with the putative teaching of *Taskett* cannot suggest the further limitation of claim 24.

In regard to the rejection of claim 26, this claim depends from claim 19 and is believed allowable at least for the reasons set forth for the allowability of claim 19.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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